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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MIKE O'DONNELL and ANDREW CAMERON

Appeal 2010-001885
Application 09/245,798
Technology Center 3600

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

INTRODUCTION

Appellants filed a Request for Reconsideration of the Board's Decision on Appeal of March 30, 2011, asking that we reconsider and reverse the Examiner's rejection of claims 126 to 147.

Appellants argue that we were mistaken in our interpretation of *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), because this case requires that there be a showing that a person having ordinary skill in the art would have seen a benefit in modifying the teachings of Johnson to implement the

method of claim 129 or the system of claim 145. Appellants argue that a person of ordinary skill in the art would not have understood the benefit of making licensee information available over a public network and that our Opinion has not stated what the predictable result would be.

We do not agree with Appellants. We said in our Opinion that a person of ordinary skill would know that adjusting the security settings in Johnson would be the use of a known method to produce predictable results (pp. 8-9). In other words, a person of ordinary skill would know that one could adjust the security settings to allow the desired persons access to the information. If one desired the benefit of allowing more people access, the security settings could be relaxed, and if one desired the benefit of allowing less people access, the security settings could be tightened. This would be only the rearrangement of known security settings using known methods, each setting and method performing the same function it had been known to perform and yielding no more than one would expect or predict from such an arrangement. *KSR*, 550 U.S. at 417.

Appellants also argue that this reasoning was first presented by the Board in the Decision and that therefore, Appellants have not previously had an opportunity to address this position. This is not correct. The Examiner used this reasoning on page 22 of the Answer.

Appellants also argue that we did not consider the arguments directed to the patentability of claims 128 and 142. We do not agree. At pages 24 to 25 of the Appeal Brief, Appellants argue in regard to claims 128 and 142 that Johnson does not disclose that electronic copies might automatically be sent to a printer without a link of human assistance. This argument was also presented with respect to the rejection of claims 126 and 129 (Brief 20). We

addressed the issue of automatically sending copies on page 5 of our Decision where we noted that the Examiner took Official Notice that it would have been well known to transmit a copy of a work to a user after he has secured rights to such work, such as by electronic means. This Official Notice is detailed at page 26 of the Answer.

The Request for Rehearing has been granted in that we have reconsidered our opinion. However, we decline to make any changes to that decision.

DENIED

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